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Rejections of claims under 35 USC 112

Applicant argues the present specification provides support for the limitation of "the volume information is the second and any subsequent volumes under the first configuration not being preserved when the memory card is operated under the second configuration" and relies on paragraph 0045, 0051 and figs. 5A, 5B and 7 of Applicant's Specification and states that "although the present specification does not explicitly use the words "not preserved," it is inherent in the claimed invention that the volume information of the second and any subsequent volumes is not preserved or stored at any place when the memory card is operated under the second (single-volume) configuration... because... the present specification does not describe that the volume information of the second and any subsequent volumes is preserved or stored at any place when the memory card is operated under the second (single-volume) configuration... although the present invention provides a memory card with compatibility between two different types of addressing: FAT-16 format (the first configuration) and FAT-32 (the second configuration), it is first determined whether the memory card has the first configuration or the second configuration, and then the memory card is operated in accordance with the determined configuration. Thus, the two different configurations or file format do not coexist in the memory card. Accordingly, when the memory card is being operated under the second configuration, there is not reason and no space to retain the volume information of the second and any subsequent volumes which only exists under the first (multi-volume) configuration."

In response, these arguments have been fully considered, but they are not deemed persuasive.

First, Applicant should note that contrary to Applicant's arguments, Applicant's Specification does not inherently provide support for "the volume information is the second and any subsequent volumes under the first configuration not being preserved when the memory card is operated under the second configuration" since contrary to Applicant's arguments, the Applicant's Specification describes that volume information in the second and any subsequent volumes is preserved when the memory card is operation under the second (single-volume) configuration and also describes maintaining both FAT-16 and FAT-32 volume information in memory card as **[in figure 7, volume information for multiple configurations (722, 723) and volume information for a single configurations (721) coexist in memory card as illustrated by the Card LBA, wherein Applicant's Specification explains "one enhancement... is to have firmware assign the initial logical address space for the first and third volume to different physical locations. The advantage of this enhancement allows the memory card to leave the factory with both FAT-16 and FAT-32 formats, thus being suitable for use by both newer and legacy systems and not requiring customer reformatting" (par. 0055) (Fig. 7 and related text)]**. Further, Applicant's Figures 5A and 5B, are not sufficient proof of preservation of volume information or the lack therefore, since there is simply no description in Applicant's Specification regarding deletion or not preserving this information and from the drawings by themselves, it is not clear what happens to the volume information. Further, it is not clear to the Examiner how the memory card claimed by Applicant would be able to be configured from a format a multiple volume configuration in FAT-16 file to a single volume in FAT-32 file format and vice versa without somehow maintaining volume information or file format information when the memory in reconfigured.

Therefore, the Examiner maintain the 35 USC 112 first paragraph rejection of claims 1-25 and 36-38 as Applicant's Specification fails to provide support for the limitation of "the volume information is the second and any subsequent volumes under the first configuration not being preserved when the memory card is operated under the second configuration.

Rejections of claims under 35 USC 103

Applicant's arguments that the combination of Suda, Moro and Murray does not disclose "the volume information in the second and any subsequent volumes under the first configuration not being preserved when the memory card is operated under the second configuration" have been fully considered, but they are not deemed persuasive.

First, the Examiner would like to direct Applicant's attention the 35 U.S.C. 112, first paragraph rejection above, wherein Applicant's Specification does not provide support for the newly added limitation of "the volume information in the second and any subsequent volumes under the first configuration not being preserved when the memory card is operated under the second configuration." Therefore, this limitation may be interpreted in light of the 35 USC 112, first paragraph above as each range of addresses which stores the volume information in a second and any subsequent volumes under the first configuration stores user data under the second configuration (which comprises that for which Applicant has provided support in Applicant's Specification); which is taught by Murray as stated in non-final rejection mailed on 12/15/2008.

The combination of Suda, Moro and Murray discloses "the volume information in the second and any subsequent volumes under the first configuration not being preserved when the

memory card is operated under the second configuration" as Murray discloses [**"A conventional approach to combining partitions begins by copying all necessary user and system data... The data copied includes without limitation the content of files created by the user... and system data... Some internal file system data such as sector allocation maps (*which comprises volume information*) may not need to be copied"** (col. 3, lines 42-52)]; therefore, it would be obvious to one having ordinary skill in the art to have the volume information in the second and any subsequent volumes under the first configuration not being preserved when the memory card is operated under the second configuration; and Moro further discloses [configuring memory card 3 as a single partition 172 or a first 162 and second 163 partitions, wherein on a configuration having a first and second partitions, volume information for the first and second partitions is maintained in 161 as "first partition information type: 06H (FAT 16)" and "second partition information type: 08h (FAT 32)" and under a configuration having a single partition 172, only single partition volume information 171 is maintained as "single partition information type: 06h (FAT 16)" (Fig. 1 and related text)]; therefore, under a single partition configuration, volume information for the second volume is not preserved.

In response to Applicant's arguments that Murray teaches away from accessing (or merging) the entire address space of the disk as a single volume because such a merge leaves no room for keeping a copy of all system data and user data during the merge; the Examiner would like to point out that the reference to Murray does not teach away from accessing (or merging) the entire address space of the disk as a single volume to obtain the claimed invention as

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Murray's disclosure does not criticize, discredit, or otherwise discourage the solution claimed *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). See also MPEP 2123.

/Yaima Campos/

Examiner, Art Unit 2185